



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,116	09/18/2000	Wilhelm F. Maier	STUDIEN 272-	7894

7590

03/12/2003

Norris McLaughlin & Marcus P A  
220 East 42nd Street  
30th Floor  
New York, NY 10017

EXAMINER

FRIEND, TOMAS H F

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/582,116

Applicant(s)

MAIER ET AL.

Examiner

Tomas Friend

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see the attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: 7.

Claim(s) rejected: 1,3-5 and 8-15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

  
**ANDREW WANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Tomas Friend, Ph.D.  
05 March 2003

### Response to Applicants' Arguments

#### **Claims Rejected under 35 U.S.C. 102/103 as being anticipated by or, in the alternative, as being unpatentable over US 6,063,633:**

Applicants' argue that the examiner has improperly gone outside of the cited reference for anticipation because the the '633 patent does not explicitly teach the recording of a difference image and that such an image is not inherent in the method disclosed in the cited reference. Applicants further argue that, with regard to obviousness, the assumption of "allegedly well-known, common knowledge" is presumptively improper and secondary reference is required for the teaching making a difference image.

Applicants' arguments have been fully considered but they are not persuasive. The '633 patent discloses the use of an IR camera to produce images under reactive and non-reactive conditions and to judge temperatures by normalizing observed IR emissions under reactive and non-reactive conditions (i.e. before and during reactions). See column 7, lines 5-33, for example. The '633 patent does not explicitly state that an image *"is obtained by subtraction of the infrared emission recorded prior to the beginning of the processes from the emission recorded during the course of the processes."* The claims are rejected under 35 U.S.C. 102 or 103 in the alternative because lines 26-31 of column 7, for example, may be interpreted to mean that an image is obtained by subtraction in the same manner as in the rejected claims. Alternatively, one skilled in the art would understand that obtaining such an image by subtraction would be one of only a small number of methods for judging the temperature of each reaction cell as disclosed in the '633 patent. The examiner has not *"going outside"* the '633 patent for anticipation because the claims are rejected under 102 or 103 in the alternative.

With respect to applicants' request for an additional reference in support of the examiner's assertion regarding difference imaging, the '633 patent discloses normalizing energy emissions from images taken under reactive and non-reactive conditions. Such a normalization would be understood by one of ordinary skill in the art to be a subtraction of baseline (i.e. non-reactive condition) emissions from emissions under reactive conditions. On page 5 of applicants'

Art Unit: 1639

remarks received 21 February 2003, applicants also use the term "*normalization*" in reference to recording infrared images at different stages of a reaction, or prior to a reaction.

**Claims Rejected under 35 U.S.C. 112, second paragraph:**

Applicants argue that, in light of the specification, one skilled in the art would readily understand that the claimed invention is directed to using black dull materials as the materials of choice for the library plate because the concept of a black body was well known in the art as being equivalent to a body with an IR-reflectivity of close to zero.

Applicants' argument has been fully considered but it is not persuasive. With regard to the IR reflectivity of black body, applicants' argument states that such a reflectivity is found, **for example**, in materials that are black and dull in appearance (emphasis added by examiner). Consequently, applicants' argument indicates that materials other than those that are black and dull in appearance may be included among those "*with an infrared reflectivity close to that of a black body.*" Additionally, applicants have not indicated how the specification could be interpreted to allow one of skill in the art to determine the metes and bounds of "*close to the infrared reflectivity of a black body*" by providing the degree of closeness encompassed by the claims as measured by any objective criteria.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tomas Friend**, telephone number (703) 308-4548. The examiner's schedule is an increased flex-time schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Tomas Friend, Ph.D.  
05 March 2003